

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

In re Application of:)	
Arthur S. Robb)	Examiner: Sunit Pandya
)	
)	Art Unit: 3714
Serial No: 10/670,555)	
)	Confirmation No.: 8125
Filed: September 23, 2003)	
)	Deposit Acct. No: 04-1403
Title: Lottery and Gaming Systems with)	
Multi-Theme Instant Win Games)	Client ID: 22827

1. ☐ **NOTICE OF APPEAL:** Pursuant to 37 CFR 41.31, Applicant hereby appeals to the Board of Appeals from the decision dated _____ of the Examiner twice/finally rejecting claims _____.
2. ☒ **BRIEF** on appeal in this application pursuant to 37 CFR 41.37 is transmitted herewith (1 copy).
3. ☐ An **ORAL HEARING** is respectfully requested under 37 CFR 41.47 (due within two months after Examiner's Answer).
4. ☐ Reply Brief under 37 CFR 41.41(b) is transmitted herewith (1 copy).
5. ☐ "Small entity" verified statement filed: [] herewith [] previously.

6. **FEE CALCULATION:**

	Fees
If box 1 above is X'd enter \$ 510.00	\$ <u>0.00</u>
If box 2 above is X'd enter \$ 510.00	\$ <u>510.00</u>
If box 3 above is X'd enter \$1,030.00	\$ <u>0.00</u>
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PETITION is hereby made to extend the original due date of _____, hereby made for an extension to cover the date this response is filed for which the requisite fee is enclosed (1 month \$120; 2 months \$460; 3 months \$1,050; 4 months \$1,640, 5 months \$2,230

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SUBTOTAL: \$ 510.00

Less any previous extension fee paid since above original due date. - \$ 0.00

Less any previous fee paid for prior Notice of Appeal since Board did not render a decision on the merits. MPEP § 1204.01 - \$ 0.00

Less any previous fee paid for submitting Brief on prior Appeal since Board did not render a decision on the merits. MPEP § 1204.01 - \$ 0.00

SUBTOTAL: \$ 510.00

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☐ herewith, enter one-half (1/2) of subtotal and subtract

- \$ 0.00

TOTAL FEE ENCLOSED: \$ 510.00

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- ☒ Charge to credit card
- ☐ Fee NOT required since paid in prior appeal in which the Board of Appeals did not render a decision on the merits.

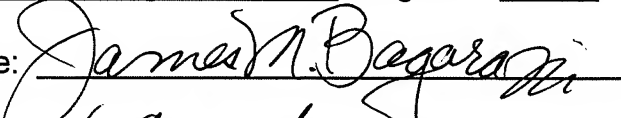
The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any fees in addition to the fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (deficiency only) now or hereafter relative to this application and the resulting official document under Rule 20, or credit any overpayment, to our Account No. shown in the heading hereof. This statement does not authorize charge of the issue fee in this case.

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Mailstop Appeal Brief – Patents
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT’S ORIGINAL BRIEF ON APPEAL

Honorable Commissioner:

Appellant submits the following brief on appeal in accordance with 37

C.F.R. § 41.37:

1. REAL PARTY IN INTEREST

The real party in interest in this matter is the assignee of record, Scientific Games International, Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Appellant or the Appellant’s legal representative which will directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.

3. STATUS OF CLAIMS

Currently, claims 1-20 remain pending in the present application. Claims 1-20, including independent claims 1, 14, and 18, were examined. All of the pending claims are attached hereto in the Claims Appendix.

In the Final Office Action of February 5, 2008 and in the Advisory Action of May 20, 2008, claims 1-20 were finally rejected under 35 U.S.C. §103(a).

The rejection of examined claims 1-20 is hereby appealed.

4. STATUS OF AMENDMENTS

To the Appellant's knowledge, all amendments have been entered into the record.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The references to pages (Pg.) and paragraphs (¶) are to Patent Application Publication No. 2005/0064925 A1.

INDEPENDENT CLAIM 1

Independent claim 1 is directed to a method of conducting an instant win game in combination with a base wagering game. (Pg. 1, ¶ 0004).

For example, as schematically shown in FIG. 7, independent claim 1 is directed to a method of conducting an instant win game in combination with a base wagering game, comprising receiving a base wagering game entry at 360 and a base wagering game wager at 362 from a player, the base wagering game entry comprising a first set of player selected at 360 or randomly generated game indicia at 358. (Pg. 1, ¶ 0004). The method further comprises receiving an instant win game wager from the player at 362. (Pg. 1, ¶ 0004). Additionally, as explained at Pg. 1, ¶ 0004, claim 1 requires that the method comprises storing a

game theme indicator as well as storing a plurality of instant win game outcome display themes that are unrelated to a theme of the base wagering game. As schematically shown in FIG. 7 and explained at Pg. 1, ¶ 0004, the method requires determining at 382 an outcome of the instant win game for the player. As schematically shown in FIG. 7 and explained at Pg. 10, ¶ 0079, the instant win game 382 is independent from the base wagering game entry at 360 such that the instant win game 382 is not dependent upon or a function of the first set of game indicia 360. Also, as explained at Pg. 1, ¶ 0004, Pg. 10, ¶ 0081 and Pg. 11, ¶ 0084, the method of conducting an instant win game in combination with a base wagering game comprises displaying the outcome of the instant win game to the player as a second set of game indicia that is unrelated to the theme of the base wagering game, the second set of game indicia being identifiable with one of the plurality of instant win game outcome themes that is determined by the stored game theme indicator. Finally, as schematically shown in FIG. 7 and explained at Pg. 1, ¶ 0004 and Pg. 11, ¶¶ 0087 and 0088, the method of independent claim 1 requires awarding the player an instant win game prize at 384 corresponding to the outcome of the instant win game.

INDEPENDENT CLAIM 14

As explained at Pg. 1, ¶ 0005 and Pg. 3, ¶ 0038, independent claim 14 is directed to a gaming system for conducting an instant win game in combination with a base wagering game, said gaming system comprising a plurality of terminal units 104. In accordance with claim 14 and as schematically shown in FIGs. 1 and 2 and explained at Pg. 4, ¶¶ 0040—0041, each terminal unit 104

comprises an input device 124 or 130 or 132 that allows a player to make a plurality of input selections and an output device 128 or 133. Each terminal unit 104 comprises a terminal unit memory device 202 (Pg. 1, ¶ 0005 and Pg. 5, ¶ 0048), a currency-accepting mechanism 212 that is capable of allowing the player to deposit a medium of currency (Pg. 1, ¶ 0005 and Pg. 5, ¶ 0049; Pg. 7, ¶ 0059), and a value-dispensing mechanism that is capable of dispensing value to the player (Pg. 1, ¶ 0005, Pg. 8, ¶ 0070, Pg. 9, ¶ 0074 and Pg. 11, ¶ 0087). As explained at Pg. 1, ¶ 0005 and Pg. 5, ¶¶ 0048 & 0049, the terminal units 104 further comprise a terminal unit controller 200. As shown schematically in FIG. 2, each terminal unit controller 200 can be operatively coupled to a display unit 128, the input device 124, the terminal unit memory device 202, the currency-accepting mechanism 212, the value-dispensing mechanism 218, and the output device 133. (Pg. 1, ¶ 0005 and Pg. 5, ¶¶ 0048 – 0050).

As schematically shown in FIGs. 1 and 2 and described at Pg. 1, ¶ 0005 and Pg. 4, ¶ 0043, the gaming system of independent claim 14 further requires a host computer 134 operatively coupled to the plurality of terminal units 104, the host computer 134 comprising a host computer memory device 138 and a host computer controller 136 operatively coupled to the host computer memory device 138. Furthermore, as schematically shown in FIGs. 5 and 6 and described in Appellant's specification (Pg. 1, ¶ 0005, Pg. 7, ¶ 0058 and Pg. 9, ¶ 0071), the terminal unit controller 200 is programmed to allow a player to enter a base wagering game entry at the input device, the base wagering game entry comprising a first set of player selected or randomly generated game indicia. As

schematically shown in FIGs. 5 and 7 and described in Appellant's specification (Pg. 1, ¶ 0006, Pg. 4, ¶ 0041 and Pg. 9, ¶¶ 0077 and 0078), the terminal unit controller 200 is additionally programmed to allow a player to make a base wagering game wager and an instant win game wager at the currency-accepting mechanism. Additionally, as described in Appellant's specification (Pg. 1, ¶ 0006 and Pg. 11, ¶ 0084), one of the terminal unit controller 200 and the host computer controller 136 is programmed to store a game theme indicator at the corresponding one of the terminal unit memory device and the host computer memory device. Also, one of the terminal unit controller 200 and the host computer controller 136 is programmed to store a plurality of instant win game outcome display themes at the corresponding one of the terminal unit memory device and the host computer memory device. (Pg. 1, ¶ 0006, Pg. 9, ¶ 0075 and Pg. 10, ¶ 0082). As required by independent claim 14 and described in Appellant's specification (Pg. 1, ¶ 0006 and Pg. 10, ¶ 0079), one of the terminal unit controller 200 and the host computer controller 136 is programmed to determine an outcome of the instant win game. As explained at Pg. 10, ¶ 0079 and schematically shown in FIG. 7 at 382, in this determination the outcome of the instant win game is independent from the base wagering game entry at 360 such that the instant win game is not dependent upon or a function of the first set of game indicia 360. As explained at Pg. 1, ¶ 0006 and Pg. 10, ¶¶ 0081 and 0082 and schematically shown in FIG. 2, the terminal unit controller 200 is programmed to display the outcome of the instant win game at the output device as a second set of game indicia that is unrelated to the theme of the base

wagering game, the second set of game indicia being identifiable with one of the plurality of instant win game outcome display themes determined by the game theme indicator. Finally, as explained at Pg. 1, ¶ 0006 and Pg. 10, ¶ 0081 and schematically shown in FIGs. 2 and 7, the terminal unit controller 200 is programmed to cause the value-dispensing mechanism to dispense an instant win game prize corresponding to the outcome of the instant win game.

INDEPENDENT CLAIM 18

As schematically shown in FIGs. 2 and 13 and explained at Pg. 2, ¶ 0007 and Pg. 12, ¶¶ 0095 and 0096, independent claim 18 discloses a terminal unit 104, 504 for conducting an instant win game in combination with a base wagering game. The terminal unit 104, 504 comprises an input device 124, 130, 132, 602, 604, 606 or 608 that allows the player to make a plurality of input selections. (Pg. 2, ¶ 0007, Pg. 4, ¶ 0040 and Pg. 12, ¶ 0096). As schematically shown in FIGs. 2 and 13 and explained at Pg. 2, ¶ 0007 and Pg. 13, ¶ 0106, the terminal unit 104, 504 comprises a memory device 202, 654. As schematically shown in FIGs. 2 and 13 and explained at ¶ 0007 on pages 2 – 3, Pg. 4, ¶ 0041 and ¶ 0096 on Pg. 12, the terminal unit 104, 504 as detailed in claim 18 requires a currency-accepting mechanism 602 and 604 that is capable of allowing the player to deposit a medium of currency. The terminal unit 104, 504 further requires a value-dispensing mechanism that is capable of dispensing value to the player. (Pg. 2, ¶ 0007, Pg. 13, ¶ 0100). Additionally, the terminal unit 104 comprises an output device. (Pg. 2, ¶ 0007, Pg. 4, ¶ 0040). The terminal unit 104, 504 also comprises a controller 200, 656 operatively coupled to the output

unit, the input device, the memory device, the currency-accepting mechanism, the value-dispensing mechanism, and the output device. (Pg. 2, ¶ 0007, Pg. 4, ¶ 0040-0041—Pg. 5, ¶ 0048 and Pg. 13, ¶ 0106). The controller 200 is programmed to allow a player to enter a base wagering game entry at the input device, the base wagering game entry comprising a first set of player selected or randomly generated game indicia. (Pg. 2, ¶ 0007, Pg. 7, ¶ 0058). The controller 200 is also programmed to allow a player to make a base wagering game wager and an instant win game wager at the currency-accepting mechanism. (Pg. 2, ¶ 0007, Pg. 4, ¶ 0041). The controller 200 is programmed to store a game theme indicator at the memory device. (Pg. 2, ¶ 0007, Pg. 11, ¶ 0084). The controller 200 is further programmed to store a plurality of instant win game outcome display themes at the memory device. (Pg. 2, ¶ 0007, Pg. 10, ¶ 0082). As explained at Pg. 2, ¶ 0007, the controller 200 is programmed to determine an outcome of the instant win game. As explained at Pg. 10, ¶ 0079 and schematically shown in FIG. 7 at 382, in this determination 382 the outcome of the instant win game is independent from the base wagering game entry at 360 such that the instant win game is not dependent upon or a function of the first set of game indicia 360. Additionally, as explained at Pg. 2, ¶ 0007 and Pg. 10, ¶ 0081, the controller 200 is programmed to display the outcome of the instant win game at the output device as a second set of game indicia that is unrelated to the theme of the base wagering game, the second set of game indicia being identifiable with one of the plurality of instant win game outcome display themes determined by the game theme indicator. Lastly, as explained at Pg. 2, ¶ 0007

and Pg. 10, ¶ 0081, the controller 200 is programmed to cause the value-dispensing mechanism to dispense an instant win game prize corresponding to the outcome of the instant win game.

6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- I. In the Final Office Action, claims 1-8 and 10-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent Publication Number 2003/0050109 to Caro et al (hereinafter "Caro et al") and further in view of US Patent Number 5,158,293 to Mullins (hereinafter "Mullins").
- II. Claims 9 and 13-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent Application Publication Number 2004/0266514 to Penrice (hereinafter "Penrice") in view of Caro et al and further in view of Mullins.

7. ARGUMENT

Appellant respectfully submits that the presently pending claims 1 – 20 are patentable over the cited references.

I. Independent claim 1 along with its respective dependent claims, is patentable over Caro et al and Mullins.

The invention of Caro et al relates to a combined future lottery and optional instant game, which utilizes a central computer connected on-line with multiple remote game terminals. (Pg. 2, ¶ 0020.) In accordance with Caro et al, the player selected game pieces are typically a set of numbers to be played in a future draw lottery game and, if chosen for play, an instant game. (Pg. 2, ¶ 0020.) If the instant game option is chosen, then the central computer generates a second set of winning game numbers using a random number generator. (Pg.

2, ¶ 0020.) The first set of player selected numbers is then compared with the second set of computer generated numbers to determine if the player has won, and if so, the nature of the prize associated with the winning match or matches. (Pg. 2, ¶ 0020.)

Mullins is directed to a game ticket that combines elements of both a scratch ticket and a jackpot type ticket. (Col. 1, lines 64-65.) As described in the specification of Mullins, the game ticket of the Mullins invention is divided in half with one-half ticket associated with the instant game and one-half ticket associated with the lottery jackpot game. (Col. 2, lines 30-33.) The Mullins instant game half-ticket has a hidden indicator covered by removable material. (Col. 2, lines 54-55.)

In contrast to Caro et al, in Appellant's claims, the entry for the instant win game is not dependent upon or a function of the indicia in the entry for the base wagering game. Furthermore, Mullins fails to remedy this deficiency in Caro et al. Thus, the combination of Caro et al and Mullins fails to render Appellant's claims obvious pursuant to 35 U.S.C. § 103(a).

A. The rejections of independent claim 1 and claims dependent thereon are based on a misunderstanding of Caro et al.

As previously argued in Appellant's response dated June 5, 2008, it is apparent from the Examiner's remarks that there is a fundamental misunderstanding of the claimed invention as it relates to Caro et al.

In Appellant's independent claim 1, the base wagering game comprises a first set of game indicia. In independent claim 1, the instant win game cannot

depend upon or be a function of the first set of game indicia and in this regard specifically requires (emphasis added):

determining an outcome of the instant win game for the player, the **instant win game being independent from the base wagering game entry** such that the instant win game is **not dependent upon or a function of the first set of game indicia**;

Lines 8 – 9 of page 3 of the February 2008 Final Office Action alleged that Caro et al discloses “determining an outcome of the instant win game for the player, independent of the base wagering game entry.” The Final Office Action cites paragraph 0049 from Caro et al as support for this allegation.

In general, Caro et al paragraph 0049 describes how the number or types of matches determines the possible winning outcomes for the instant win game.

Caro et al paragraph 0049 specifically states (emphasis added):

[0049] Matches for the instant game are determined by the player examining the ticket. The central computer also calculates matches, and records the result and the prize associated with a particular "win" result. In general, certain matches, and/or certain quantities and positional order of matches, are associated with different prize values. In general, the larger the number of matches, or matches in a specific order, the greater the prize. The tickets 12 will typically include a visual indication 28 of the prize associated with a particular match, or number of matches, and for matches in a specified order. The prize indication can be a displayed amount of money, a symbol or picture of a prize, and/or a table showing the odds and prize amounts for all possible winning outcomes. If there are no matches, the instant game is lost and the additional purchase price for the option of playing the game is forfeit. However, the player continues to have the opportunity to play, and possibly win, the future lottery game. **With the same player-selected set of numbers, play is therefore extended, and play value of the game increased.**

Thus, Caro et al paragraph 0049 fails to disclose that the outcome for the instant win game is independent of the base wagering game entry. In fact, Caro et al paragraph 0049 specifically teaches that once the outcome of the instant win game is determined, the player still has a chance to possibly win the future lottery game “[w]ith the same player-selected set of numbers, play is therefore extending, and play value of the game increased.” Caro et al Pg. 5, ¶ 0049 (emphasis added). In contrast to the Final Office Action’s interpretation of Caro et al, the reference specifically discloses that the player-selected numbers are used for the instant win game as well as the future lottery game. As such, these two games are not independent. As shown above, in Caro et al, the entry for the instant win game is dependent upon or a function of the indicia (the same set of numbers) in the entry for the base wagering game.

Referring to paragraphs 0048 and 0049 on page 4 of Caro et al, the Advisory Action dated May 20, 2008 alleged that:

Caro clearly teaches of having two sets of independent numbers which are used to play bonus game and future lottery game respectively. The only relationship those numbers have between them is the (sic) that they might have been coincidentally selected by the Random number generator. As seen in figure 2A, the element #26 are the numbers, produced randomly by a RNG (Random number generator) for the instant win game and element #30 are the numbers for the lottery game, and clearly they are independent of each other.

Appellant respectfully disagrees with the May 2008 Advisory Action’s interpretation of Caro et al. Caro et al FIG. 2A is shown below:

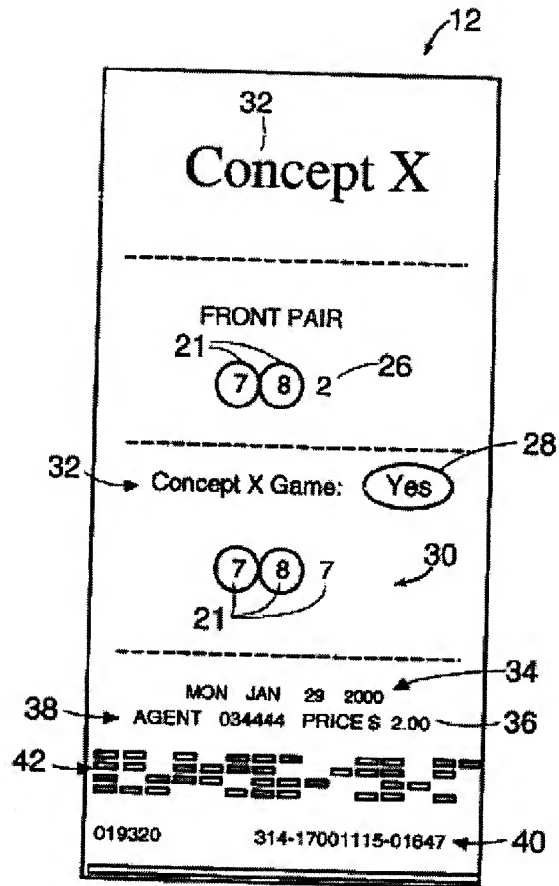


FIG. 2A

According to Caro et al, “[p]lay of the instant game involves matching the player-selected numbers from the first set 26 with a like-type of numbers from the second set 30. The second set 30 is produced from the available field of numbers by the random number generation 24.” (Pg. 4, ¶ 0048.) Based on Caro et al’s own description of FIG. 2A, the first set of numbers 26 are chosen by the player, and the second set of numbers 30 are produced by a random number generator. The description of elements 26 and 30 in Caro et al clearly contradicts the interpretation of these same elements as put forth in the Advisory Action. The outcomes of both the instant win game and the future lottery game

are dependent on the single set of player-selected numbers 26. For example, in FIG. 2A the player-selected numbers are 7, 8, and 2—the randomly generated numbers are 7, 8, and 7. Because the numbers 7 and 8 appear in both sets of numbers, there are two matches in the instant win game. This specific outcome corresponds to a certain “win” result. Therefore, the instant win game disclosed in Caro et al is dependent on the indicia (7, 8 and 2) in future lottery game entry, unlike independent claim 1.

In addition to those passages already cited from Caro et al, there is additional support for Appellant’s contention that the instant win game of Caro et al is, in fact, dependent on the indicia of the base wager game entry. The gaming process as described in Caro et al further supports Appellant’s assertion. “The player selected games pieces are typically a set of numbers to be played in a future draw lottery game and, if chosen for play, an instant game.” Caro et al Pg. 2, ¶ 0020 (emphasis added). If the player elects to play the instant win game, then a computer selects a second set of winning game numbers using a random number generator. “This second, randomly generated set is matched with the first player selected set to determine if the player has won, and if so, the nature of the prize associated with the winning match or matches.” Caro et al Pg. 2, ¶ 0020.

As shown above, Caro et al repeatedly describes the same set of player-selected numbers being used for both the future lottery game and the instant win game. Caro et al simply fails to disclose or suggest that the instant win game is independent from the base wager game entry as asserted by the Advisory

Action. As such, Appellant submits that Caro et al does not disclose the elements of independent claim 1 as alleged by the Final Office Action. Appellant therefore respectfully submits that claims 1-8 and 10-12 are patentable under 35 U.S.C. § 103(a) Caro et al in view of Mullins.

II. Independent claims 14 and 18 along with their respective dependent claims, are patentable under 35 U.S.C. § 103(a) over Penrice in view of Caro et al and further in view of Mullins.

As admitted in double-spaced lines 9 – 10 on page 8 of the Final Office Action, Penrice fails to teach providing a lottery game that includes a base wagering game and an instant win game. In order to overcome this deficiency, at double-spaced line 20 on page 8 through line 1 on page 9 of the Final Office Action, the Final Office Action incorporates the teachings of Caro et al into those of Penrice.

However, Appellant's claim 14 requires (emphasis added):

one of the terminal unit controller and the host computer controller being programmed to determine an outcome of the instant win game, the outcome of the **instant win game being independent from the base wagering game entry** such that the instant win game is **not dependent upon or a function of the first set of game indicia**

Similarly, Appellant's claim 18 requires (emphasis added):

the controller being programmed to determine an outcome of the instant win game, the outcome of the **instant win game being independent from the base wagering game entry** such that the instant win game is **not dependent upon or a function of the first set of game indicia**

As to the above-quoted elements of claims 14 and 18, the Final Office Action contends at lines 19 – 21 of page 10 thereof that the combination of Penrice and Caro et al teaches a game system for conducting an instant win game in combination with a base wagering game over a network (emphasis added):

wherein the terminal unit controller (MP 104) is programmed to determine the outcome of the **instant win game, which is independent from the base game entry** (also see **Caro et al. paragraph [0049]**),

However, Appellant disagrees with this contention. To the contrary, Appellant contends that the combined teachings of Penrice and Caro et al fail to disclose an instant win game in combination with a base wagering game wherein the outcome of the instant win game is independent from the base wagering game entry such that the instant win game is not dependent upon or a function of the first set of game indicia.

The Final Office Action admits that gaming system of Penrice fails to incorporate both an instant win game and a base wagering game. As such, the Final Office Action relies solely on Caro et al in order to disclose the elements quoted above from independent claims 14 and 18. In this regard recall that similar to the above-quoted elements of claims 14 and 18, claim 1 requires (emphasis added):

determining an outcome of the instant win game for the player, the **instant win game being independent from the base wagering game entry** such that the instant win game is **not dependent upon or a function of the first set of game indicia**;

As argued above in section I. with respect to Appellant's independent claim 1, the Caro et al and Mullins references do not disclose the claim 1 element quoted above. Appellant respectfully submits that the arguments of section I. are similarly applicable for claims 14 and 18, and thus Appellant contends that the Caro et al and Mullins references fail to disclose the similar above quoted elements from Appellant's claims 14 and 18. Hence, Appellant respectfully submits that these independent claims 14 and 18 and their dependent claims are allowable in view of the previously made arguments in section I.

Accordingly, it is respectfully submitted that the independent claims 14 and 18 are allowable under 35 U.S.C. § 103(a) over the combination of Penrice, Caro et al and Mullins. Further, any dependent claims of claims 14 and 18 are allowable for at least the reasons claims 14 and 18 are allowable.

In conclusion, Appellant requests favorable action and allowance of the presently pending claims 1 – 20.

8. **CLAIMS APPENDIX**

1. (Previously Presented) A method of conducting an instant win game in combination with a base wagering game, comprising:

receiving a base wagering game entry and a base wagering game wager from a player, the base wagering game entry comprising a first set of player selected or randomly generated game indicia;

receiving an instant win game wager from the player;

storing a game theme indicator;

storing a plurality of instant win game outcome display themes that are unrelated to a theme of the base wagering game;

determining an outcome of the instant win game for the player, the instant win game being independent from the base wagering game entry such that the instant win game is not dependent upon or a function of the first set of game indicia;

displaying the outcome of the instant win game to the player as a second set of game indicia that is unrelated to the theme of the base wagering game, the second set of game indicia being identifiable with one of the plurality of instant win game outcome display themes that is determined by the stored game theme indicator; and

awarding the player an instant win game prize corresponding to the outcome of the instant win game.

2. (Original) The method of conducting an instant win game in combination with a base wagering game according to claim 1, wherein the instant

win game and base wagering game are implemented in a gaming system having a host computer communicatively linked to a plurality of terminal units, the method comprising receiving the base wagering game entry, base wagering game wager and instant win game wager at one of the terminal units.

3. (Original) The method of conducting an instant win game in combination with a base wagering game according to claim 2, comprising determining the outcome of the instant win game for the player at one of the host computer and the one of the plurality of terminal units receiving the base wagering game entry, base wagering game wager and instant win game wager.

4. (Original) The method of conducting an instant win game in combination with a base wagering game according to claim 2, comprising displaying the outcome of the instant win game to the player at the one of the plurality of terminal units receiving the base wagering game entry, base wagering game wager and instant win game wager.

5. (Previously Presented) The method of conducting an instant win game in combination with a base wagering game according to claim 4, wherein each of the terminal units includes a ticket printer, the method comprising printing a ticket at the ticket printer of the one the plurality of terminal units, the ticket including the first set of game indicia corresponding to the base wagering game entry and base wagering game wager, and the second set of game indicia corresponding to the outcome of the instant win game with the one of the instant win game outcome display themes corresponding to the stored game theme indicator.

6. (Original) The method of conducting an instant win game in combination with a base wagering game according to claim 4, wherein each of the terminal units includes video display device, the method comprising displaying the outcome of the instant win game at the video display device of the one of the terminal units, the outcome of the instant win game being displayed with the one of the instant win game outcome display themes corresponding to the stored game theme indicator.

7. (Original) The method of conducting an instant win game in combination with a base wagering game according to claim 1, wherein the instant win game and base wagering game are implemented in a gaming system having a host computer communicatively linked to a plurality of terminal units, the method comprising storing the game theme indicator at one of the host computer and the terminal units.

8. (Original) The method of conducting an instant win game in combination with a base wagering game according to claim 1, wherein the instant win game and base wagering game are implemented in a gaming system having a host computer communicatively linked to a plurality of terminal units, the method comprising storing the plurality of instant win game outcome display themes at the plurality of terminal units.

9. (Original) The method of conducting an instant win game in combination with a base wagering game according to claim 1, wherein the instant win game and base wagering game are implemented in a gaming system having a host computer communicatively linked to a plurality of terminal units

each having a value dispensing unit, the method comprising dispensing the instant win game prize to the player via the value dispensing unit.

10. (Previously Presented) The method of conducting an instant win game in combination with a base wagering game according to claim 1, wherein the instant win game and the base wagering game are implemented in a terminal unit having an input device, the method comprising receiving the base wagering game entry, base wagering game wager and instant win game wager at the input device of the terminal units.

11. (Previously Presented) The method of conducting an instant win game in combination with a base wagering game according to claim 10, wherein the terminal unit includes a ticket printer, the method comprising printing a ticket at the ticket printer of the terminal unit, the ticket including the first set of game indicia corresponding to the base wagering game entry and base wagering game wager, and the second set of game indicia corresponding to the outcome of the instant win game with the one of the instant win game outcome display themes corresponding to the stored game theme indicator.

12. (Original) The method of conducting an instant win game in combination with a base wagering game according to claim 10, wherein the terminal unit includes a video display device, the method comprising displaying the outcome of the instant win game at the video display device of the terminal unit, the outcome of the instant win game being displayed with the one of the instant win game outcome display themes corresponding to the stored game theme indicator.

13. (Original) The method of conducting an instant win game in combination with a base wagering game according to claim 1, wherein the instant win game and base wagering game are implemented in a terminal unit having a value dispensing unit, the method comprising dispensing the instant win game prize to the player via the value dispensing unit.

14. (Previously Presented) A gaming system for conducting an instant win game in combination with a base wagering game, said gaming system comprising:

a plurality of terminal units, each of the terminal units comprising:

an input device that allows a player to make a plurality of input selections;

a terminal unit memory device;

a currency-accepting mechanism that is capable of allowing the player to deposit a medium of currency;

a value-dispensing mechanism that is capable of dispensing value to the player;

an output device; and

a terminal unit controller operatively coupled to a display unit, the input device, the terminal unit memory device, the currency-accepting mechanism, the value-dispensing mechanism, and the output device; and

a host computer operatively coupled to the plurality of terminal units, the host computer comprising a host computer memory device and a host computer controller operatively coupled to the host computer memory device,

the terminal unit controller being programmed to allow a player to enter a base wagering game entry at the input device, the base wagering game entry comprising a first set of player selected or randomly generated game indicia,

the terminal unit controller being programmed to allow a player to make a base wagering game wager and an instant win game wager at the currency-accepting mechanism,

one of the terminal unit controller and the host computer controller being programmed to store a game theme indicator at the corresponding one of the terminal unit memory device and the host computer memory device,

one of the terminal unit controller and the host computer controller being programmed to store a plurality of instant win game outcome display themes at the corresponding one of the terminal unit memory device and the host computer memory device,

one of the terminal unit controller and the host computer controller being programmed to determine an outcome of the instant win game, the outcome of the instant win game being independent from the base wagering game entry such that the instant win game is not dependent upon or a function of the first set of game indicia,

the terminal unit controller being programmed to display the outcome of the instant win game at the output device as a second set of game indicia that is unrelated to the theme of the base wagering game, the second set of game indicia being identifiable with one of the plurality of instant win game outcome display themes determined by the game theme indicator, and

the terminal unit controller being programmed to cause the value-dispensing mechanism to dispense an instant win game prize corresponding to the outcome of the instant win game.

15. (Previously Presented) The gaming system for conducting an instant win game in combination with a base wagering game according to claim 14, wherein the output device comprises a ticket printer, wherein the terminal unit controller is programmed to print a ticket including the first set of game indicia corresponding to the base wagering game entry and base wagering game wager, and the second set of game indicia corresponding to the outcome of the instant win game with the one of the instant win game outcome display themes corresponding to the stored game theme indicator.

16. (Original) The gaming system for conducting an instant win game in combination with a base wagering game according to claim 14, wherein the output device comprises a video display device, wherein the terminal unit controller is programmed to display the outcome of the instant win game at the video display device, the outcome being displayed with the one of the instant win game outcome display themes corresponding to the stored game theme indicator.

17. (Original) The gaming system for conducting an instant win game in combination with a base wagering game according to claim 14, wherein the host computer controller is programmed to determine the outcome of the instant win game, wherein the host computer controller is programmed to store the game theme indicator at the host computer memory device, wherein the terminal

unit controller is programmed to store the plurality of instant win game outcome themes at the terminal unit memory device, and wherein the host computer controller is programmed to transmit the outcome of the instant win game and the game theme indicator to the terminal unit.

18. (Previously Presented) A terminal unit for conducting an instant win game in combination with a base wagering game, said terminal unit comprising:

- an input device that allows the player to make a plurality of input selections;

- a memory device;

- a currency-accepting mechanism that is capable of allowing the player to deposit a medium of currency;

- a value-dispensing mechanism that is capable of dispensing value to the player;

- an output device; and

- a controller operatively coupled to the output unit, the input device, the memory device, the currency-accepting mechanism, the value-dispensing mechanism, and the output device,

- the controller being programmed to allow a player to enter a base wagering game entry at the input device, the base wagering game entry comprising a first set of player selected or randomly generated game indicia,

- the controller being programmed to allow a player to make a base wagering game wager and an instant win game wager at the currency-accepting

mechanism,

the controller being programmed to store a game theme indicator at the memory device and,

the controller being programmed to store a plurality of instant win game outcome display themes at the memory device,

the controller being programmed to determine an outcome of the instant win game, the outcome of the instant win game being independent from the base wagering game entry such that the instant win game is not dependent upon or a function of the first set of game indicia,

the controller being programmed to display the outcome of the instant win game at the output device as a second set of game indicia that is unrelated to the theme of the base wagering game, the second set of game indicia being identifiable with one of the plurality of instant win game outcome display themes determined by the game theme indicator, and

the controller being programmed to cause the value-dispensing mechanism to dispense an instant win game prize corresponding to the outcome of the instant win game.

19. (Previously Presented) The terminal unit for conducting an instant win game in combination with a base wagering game according to claim 18, wherein the output device comprises a ticket printer, wherein the controller is programmed to print a ticket including the first set of game indicia corresponding to the base wagering game entry and base wagering game wager, and the second set of game indicia corresponding to the outcome of the instant win

game with the one of the instant win game outcome display themes corresponding to the stored game theme indicator.

20. (Original) The terminal unit for conducting an instant win game in combination with a base wagering game according to claim 18, wherein the output device comprises a video display device, wherein the controller is programmed to display the outcome of the instant win game at the video display device, the outcome being displayed with the one of the instant win game outcome display themes corresponding to the stored game theme indicator.

9. **EVIDENCE APPENDIX**

None.

10. **RELATED PROCEEDINGS APPENDIX**

None.

Respectfully submitted,

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